

### Remarks

The 2/28/03 Office Action has indicated that claims 1-3 are rejected under 35 USC 102(b) as being anticipated by, or in the alternative under 35 USC 103(a) as being obvious over Kishimoto, US 4,272,616 stating that:

"Kishimoto discloses can claims compositions of nonionic surfactants reading on those claimed in combination with alkali metal thiocyanates. Kishimoto (claim 7) discloses a ratio of surfactant to thiocyanate of 1:0.1 to 1:5.0. Said range overlaps the range of claim 1.

The compositions of Kishimoto are above the critical micelle concentration and would form the liquid crystalline phases of claims 2 and 3 inherently since the compounds read on those instantly claimed.

To the extent that the Kishimoto reference differs from the compositions in the exemplified combination, it would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to vary the concentrations and the materials within the teachings of the Kishimoto reference for their use in photography as a radiation sensitive antistatic layer material."

Applicant is confused by the language used in the Office Action, viz:

"rejected under 35 USC 102(b) as being anticipated by, or in the alternative under 35 USC 103(a) as being obvious over Kishimoto, US 4,272,616".

As stated using the subjunctive "or", the English language commands that this statement means that the claims are rejected under only one of either section 35 USC 102 OR 35 USC 103(a).

Surely, if claims 1-3 were rejected under both of these sections, then the Office Action would have clearly stated that the claims were rejected as being anticipated AND as being obvious.

Therefore, Applicant realizes that only one of these sections applies, but is confused as to which of the sections the Office Action seeks to apply to the claims 1-3. Applicant respectfully submits

that this subjunctive language puts him at a disadvantage, as the rejection of claims 1-3 is indefinite as to which section of the law is being applied to claims 1-3. Applicant respectfully submits that this indefinite rejection adds un-necessary toil to the task of patent prosecution by tacitly admitting that an extraneous ground of rejection is included in the Office Action, and prays for a more definite statement, or correction of this error.

Nevertheless, Applicant feels compelled even in view of confusion caused by the indefiniteness of the rejection levied against his claims 1-3 to show that neither of these grounds of alleged rejection are applicable to the instantly-pending claims 1-3.

#### **Claim Rejections under 35 USC 102(b)**

As regards alleged claim rejections under 35 USC 102, Applicant notes that in order for a rejection under this section to be proper, "the reference must teach every aspect of the claimed invention" (MPEP 8<sup>th</sup> ed., Aug. 2001; pp. 700-20, col. 1, beginning with the last sentence).

In the present case of claims 1-3, not all features of Applicant's claims are disclosed in the Kishimoto reference, specifically, the range of 30 to 80 ethylene-oxy groups per molecule in claims 1 and 3, as amended herein to read. Support for such amendment is found in the second sentence on page 8 of the published international application. Claim 2 has been amended for purposes of clarity so that the former language reciting: "said mixture" now reads: "the mixture according to claim 1". Since the range of 30-80 miles ethylene-oxy groups is not present in the compounds present (ethoxylated non-ionic surfactants) in the compositions of Kishimoto relied upon for making the rejection, the Kishimoto reference no longer contains all of the limitations present in applicants claims 1-3, and a rejection of claims 1-3 under § 102(b) is not applicable.

### Claim Rejections 35 USC § 103

With regards to the making a *prima facie* case of obviousness under 35 USC §103(a), Applicant notes that MPEP section 706.02(j) sets forth the three basic criteria which must be met:

- "1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based upon applicant's disclosure."

As regards a possible rejection of claims 1-3 under 35 USC §103(a), the only basis for such a rejection in the Office Action is stated as:

"To the extent that the Kishimoto reference differs from the compositions in the exemplified combination, it would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to vary the concentrations and the materials within the teachings of the Kishimoto reference for their use in photography as a radiation sensitive antistatic layer material."

Thus, no "suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" has been identified by the Office Action, and number 1) above is not met.

Similarly, the Office Action fails to show number 3), that: "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

be found in the prior art and not based upon applicant's disclosure." No passage is identified where the prior art teaches the desirability of modifying the prior art to arrive at Applicants' claims.

Number 2) states that "there must be a reasonable expectation of success." One key question your undersigned Agent would then propose is: "Reasonable success for what result ?"

It has been asserted by the Office Action that the properties claimed in Applicants invention are inherent in the prior art of Kishimoto. The Examiner is respectfully requested to consider what now follows, as a whole, and then reconsider whether or not a prima facie case of obviousness exists with regards to claims 1-3 in view of the prior art of record and the amendments to claims 1-3 made herein.

Kishimoto is in the photographic art, whereas the present invention relates to structured liquid surfactants. Kishimoto addresses the un-related problem of anti-static properties of a film surface, but it nowhere mentions the problem addressed by the present inventor, namely that of phase instability of structured liquid surfactants. Kishimoto nowhere contains any indication that would suggest to one of ordinary skill that any of the salt/surfactant combinations it describes would be useful for the purpose discovered by Applicant. Furthermore, Kishimoto does not disclose a non-ionic surfactant emulsion, G-phase or structured surfactant composition, which are all essential features of Applicant's claims, as amended herein to recite. The statement in the Office Action that compositions above the CMC inherently fall in this group is incorrect. The CMC defines the lower concentration limit of the L1-phase, which is stated at page 3 last paragraph of Applicants' specification to be a clear micellular solution, as opposed to a surfactant emulsion, and specifically not a g-phase of structured surfactant. The reference to cloud point

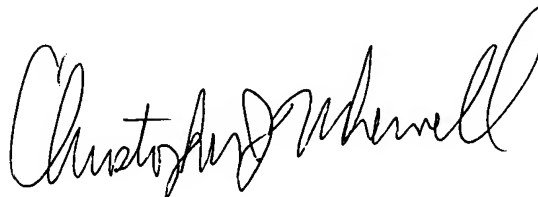
teaches away from our invention. The cloud point defines the upper limit of the L1 phase. Thus, the teaching that salts such as thiocyanate promote the formation of a clear micellar, unstructured phase by the prior art of Kishimoto teaches away from Applicant's finding in a liquid crystal surfactant system, that, in conjunction with Applicant's specific non-ionics, they inhibit the formation of a clear micellar L2 phase.

Further, Kishimoto column 7, lines 49-55 states that "It is believed that since the salts raise the cloud point of the nonionic surfactant they have the function of salting-in the surface active agent". Applicant's compositions are all liquid crystal, and are therefore above the cloud point, since liquid crystals only form above the cloud point. Applicant's invention does not employ thiocyanate to salt-in the non-ionic surfactant, since that would destroy the structure of the structured liquid surfactant and go against Applicant's discovery. While not wishing to be bound by any particular theory, Applicant believes that it is possible that the thiocyanate is functioning to replace water molecules that are hydrogen bonded to the polyoxyethylene groups. Without the thiocyanate, at elevated temperatures this water comes off the polyoxyethylene chains, and causes a phase change. With the thiocyanate, this does not occur since it sticks to the chains better.

In view of the foregoing, Applicant believes that the present amendments to the claims places all of pending claims 1-8 in condition for allowance. The Examiner is respectfully requested to reconsider the rejection of claims 1-3 under 35 USC 103(a) in view of the amendments to the claims and the remarks set forth herein.

All communications in regards to this matter should be directed to the undersigned Agent at the address below. Thank you for your consideration.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Christopher J. Whewell". The signature is fluid and cursive, with the first name "Christopher" and last name "Whewell" clearly distinguishable.

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